



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,688	09/12/2003	Carlos Alberto Godoy	741014.1021	9781

21831 7590 07/28/2004

STEINBERG & RASKIN, P.C.  
1140 AVENUE OF THE AMERICAS, 15th FLOOR  
NEW YORK, NY 10036-5803

EXAMINER

WRIGHT, ANDREW D

ART UNIT PAPER NUMBER

3617

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/662,688

Applicant(s)

GODOY, CARLOS ALBERTO

Examiner

Andrew Wright

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/12/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the fairing projecting sideways to a thickness not less than that of the respective buckle (claims 6 and 9) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

2. Claims 1, 5, 8, 9, and 10 are objected to because of the following informalities.

Appropriate correction is required.

3. Claim 1 recites "a relatively yielding material" in line 3 and in lines 8-9 when referring to the same element. It is improper to positively recite the same element twice.

4. Claim 5 recites the limitation "the closure strap" in line 4. There is insufficient antecedent basis for this limitation in the claim. A positive recitation will be assumed for examination.

5. Claim 8 recites the limitation "the lining of the lateral ribs" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim. The lining is positively recited in claim 2. It will be assumed that claim 8 depends from claim 2 instead of from claim 1.

6. Claim 9 recites "a relatively yielding material" in line 3 and "a yielding material" in line 6 when referring to the same material. It is improper to positively recite the same element twice.

7. Claim 9 recites the limitation "the closure strap" in line 10. There is insufficient antecedent basis for this limitation in the claim. A positive recitation will be assumed for examination.

8. Claim 10, line 5, the word "enlarges" should be "engages".

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3617

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 6 recites the limitation "the lining of the ribs" in line 2. Claim 6 recites the limitation "the lateral fairings" in lines 2-3. There is insufficient antecedent basis for these limitations in the claim. The lining and fairings are positively recited in claims 2 and 4 respectively. It can't be assumed that claim 6 depends from claim 4 because claim 6 refers to elements of claim 5. Therefore the scope of the claim is unclear.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Garofalo (US 5,443,593). Garofalo shows a swim fin with a shoe (2) and a blade (1). Shoe is made of soft material, and blade is made of more rigid material (column 1, lines 60-65). Blade has lateral ribs (5). Blade has longitudinal slots (102, 102') and openings (101, 101'). The slots are symmetric about the long axis of the fin. The openings extend diagonally from the shoe toward the lateral edges of the blade at least along a portion of the

opening. The slots and openings are filled with the same material as the shoe (column 2, lines 3-5).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garofalo (US 5,443,593) in view of Semeia (US 6,568,974). Regarding claim 2, Garofalo does not show that the ribs (5) are lined with the soft material. Semeia shows a swim fin with a composite structure like that of Garofalo. Semeia shows a frame (4) of rigid material, and the remainder of the swim fin, including the shoe, slots and openings in the frame, and a lining around lateral edges of the frame, being of a softer material. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Garofalo by lining the ribs (5) with the softer material as taught by Semeia. The motivation would be to optimize the feel and hydrodynamic efficiency of the swim fin.

16. Regarding claim 8, Garofalo shows a curb (401) at the front free edge of the blade. The curb is made of soft material and connects the soft material in the slots and openings. Semeia shows that the lining of the ribs extends all the way to the front edge of the ribs. Therefore the lining would intersect the curb.

17. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garofalo in view of Semeia as applied to claim 2 above, and further in view of Mehrmann et al. (US 6,224,443). Semeia teaches that two or more different materials can be used for making the various parts of the frame, which includes the lateral ribs. Mehrmann shows a flipper made of different hardness materials. The shoe can be made of soft 30 durometer material, the blade of rigid 90 durometer material, and the lateral ribs of intermediate 80 durometer material. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Garofalo by making the ribs from a material with intermediate hardness. The motivation would be to optimize the hydrodynamic performance of the swim fin.

18. Regarding claim 4, both Garofalo and Semeia show that the ribs enlarge in the rearward direction. Therefore the lining on the rib would also enlarge along with the rib. The structure can be considered a fairing.

19. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garofalo (US 5,443,593) in view of Takizawa (US 5,304,081). Garofalo does not show the rearward extent of the blade, and does not show the connections for a strap. Garofalo does show that the lateral rib portion of the blade flanks the foot pocket. And that portions of the blade form flanks at the sides of the front part of the shoe. Takizawa shows a swim fin with a shoe and blade. The blade has lateral ribs. The ribs extend rearward to form flanking portions of the shoe. The portions terminate in a hood with a

Art Unit: 3617

seating for buckle (5) to engage. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Garofalo by extending the ribs rearward and providing a seating for a buckle for a strap. The motivation would be to provide a known apparatus for connecting a heel strap for the purpose of keeping a user's foot inside the pocket.

20. Regarding claim 7, the thickness of the section (3) of Garofalo, from the bottom of the curvature to the top of the flat portion as shown in figure 2, is greater than the thickness of any portion of the blade.

21. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garofalo (US 5,443,593) in view of Semeia (US 6,568,974) and Takizawa (US 5,304,081).

Garofalo shows a swim fin with a shoe (2) and a blade (1). Shoe is made of soft material, and blade is made of more rigid material (column 1, lines 60-65). Blade has lateral ribs (5). Semeia shows a swim fin with a composite structure like that of Garofalo. Semeia shows a frame (4) of rigid material, and the remainder of the swim fin, including the shoe and a lining around lateral edges of the frame, being of a softer material. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Garofalo by lining the ribs (5) with the softer material as taught by Semeia. The motivation would be to optimize the feel and hydrodynamic performance of the swim fin. Garofalo does not show the rearward extent of the blade, and does not show the connections for a strap. Garofalo does show that the lateral rib portion of the blade flanks the foot pocket. And that portions of the



Art Unit: 3617

blade form flanks at the sides of the front part of the shoe. Takizawa shows a swim fin with a shoe and blade. The blade has lateral ribs. The ribs extend rearward to form flanking portions of the shoe. The portions terminate in a hood with a seating for buckle (5) to engage. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Garofalo by extending the ribs rearward and providing a seating for a buckle for a strap. The motivation would be to provide a known apparatus for connecting a heel strap for the purpose of keeping a user's foot inside the pocket. It is noted that the term "sideways" is not given any relative meaning the claim. The lateral rib (6) of Takizawa extends sideways in a direction from the bottom of the shoe toward the top of the shoe. In this direction the rib has a thickness not less than that of the buckle (5).

### ***Allowable Subject Matter***

22. Claims 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Paolo ('439) shows a swim fin made of different materials, one being a lining of the lateral ribs. Alvarez De Toledo ('865) shows a swim fin made of three different materials with different rigidity, and further shows that different shapes

Art Unit: 3617

and configurations of the materials can be used (figure 7). Garofalo ('334) shows a swim fin heel strap buckle.

24. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number (703) 308-6841. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at (703) 308-0230. The fax number for official communications is 703-872-9306. The fax number directly to the examiner for unofficial communications is 703-746-3548.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew D. Wright  
Patent Examiner  
Art Unit 3617

**ANDREW D. WRIGHT**  
**PRIMARY EXAMINER**

*AW* 7/26/04